

### **REMARKS/ARGUMENTS**

This Response is submitted in reply to the Office Action dated July 26, 2006, and within the three month period for reply extending to October 26, 2006. Claims 1-16 remain pending.

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#### **Premature Finality of Office Action Dated July 26, 2006**

The Office Action Summary provided with the Office Action dated July 26, 2006, indicated that the Office Action was final. However, there was no indication in the Office Action itself of the finality. In the Office Action, the Examiner provided new grounds of rejection. The Applicants previous response of April 27, 2006, did not amend any claims. Moreover, all pending claims following entry of the Applicants previous response of April 27, 2006, were the originally filed claims. Therefore, the Office's new grounds of rejection were not necessitated by an amendment in the previous Office Action response. Consequently, the outstanding Office Action of July 26, 2006, should be NON-FINAL.

15 A telephone interview was conducted between Applicant's agent Kenneth D. Wright and examiner Syed Zia on September 25, 2006, to discuss the appropriateness of the finality of the Office Action dated July 26, 2006. In the interview, Examiner Zia conceded that the indication of finality in the Office Action Summary was incorrect, and that the Office Action dated July 26, 2006, should have been non-final.

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#### **Rejections under 35 U.S.C. 102**

Claims 1-16 were rejected under 35 U.S.C. 102(e) as being anticipated by Petit (U.S. Patent No. 6,931,381). These rejections are traversed.

Petit teaches a process for allowing an issuer of a smart card to authenticate the download of software onto the smart card by a trusted third party. Petit (4:6-12) teaches

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that an issuer of a smart card delegates a third party to download software onto the smart card. Petit (3:58-61) teaches that after receiving the software download from the third party, the smart card computes a signature based on the downloaded software. Petit (4:14-16) specifically teaches that the signature cannot be computed by the smart card until  
5 after the software is downloaded from the third party to the smart card.

Petit (3:62-64) teaches that after the smart card computes the signature, the computed signature is transmitted from the smart card to the issuer (of the smart card) for verification. Petit (4:4-5 and 4:23-31) teaches that the issuer (of the smart card) tests the computed signature as received from the smart card against an expected result known to  
10 the issuer. According to Petit, if this test shows that the signature computed by the smart card matches the expected result, the issuer of the smart card considers that the software download from the third party to the smart card was successful.

It should be understood from the teachings of Petit that the software download from the third party to the smart card is not accompanied by a download of a signature  
15 associated with the software. In other words, the smart card of Petit does not receive a downloaded signature. It should be further understood from the teachings of Petit that the signature generated by the smart card based on the downloaded software is transmitted to the issuer of the smart card for comparison with the expected result. Thus, the smart card does not compare the signature generated locally thereon with an expected result  
20 available to the smart card. Petit does not teach that the expected result used to verify the signature generated by the smart card is available to the smart card.

With regard to claim 1, the Office asserts that the download of software from the third party to the smart card is analogous to the recited feature of downloading said unsigned binary to a second computing device. However, with this assertion, the third  
25 party would also have to download said first signature to the second computing device.

As discussed above, Petit does not teach that a signature is downloaded from the third party, or any entity for that matter, to the smart card. Furthermore, the Office's assertion necessitates that third party represents the recited first computing device. Thus, to anticipate claim 1, Petit would have to teach that the unsigned binary, i.e., software, is signed on the third party to obtain a first signature. As discussed above, Petit simply teaches that the third party is delegated by the issuer of the smart card to download software (not a signature) to the smart card. Petit does not teach that the third party downloads a signature to the smart card.

For a claim to be anticipated under 35 U.S.C. 102, each and every feature of the claim must be taught by a single prior art reference. Based at least on the foregoing, Petit does not teach downloading said first signature and said unsigned binary to a second computing device as required by claim 1. Therefore, the Applicants submit that claim 1 is not anticipated by Petit under 35 U.S.C. 102. The Office is requested to withdraw the rejection of claim 1 under 35 U.S.C. 102.

In rejecting claim 9, the Office has used the same teachings of Petit as asserted against similar features recited in claim 1. Therefore, the Applicants arguments against Petit as provided with regard to features of claim 1 are equally applicable to similar features of claim 9. Therefore, Petit does not teach downloading said first signature and said unsigned binary to a second computing device as required by claim 9. The Applicants submit that claim 9 is not anticipated by Petit under 35 U.S.C. 102. The Office is requested to withdraw the rejection of claim 9 under 35 U.S.C. 102.

Because a dependent claim incorporates each and every feature of its independent claim, the dependent claim is patentable for at least the same reasons as its independent claim. Therefore, each of dependent claims 2-8 and 10-16 is patentable for at least the

same reasons provided for its independent claim. The Office is requested to withdraw the rejections of claims 2-8 and 10-16 under 35 U.S.C. 102.

In considering the Applicants arguments above with regard to the rejections under 35 U.S.C. 102, the Office is requested to consider the substantial body of case law that has well-established that the standard for lack of novelty (i.e., "anticipation") under 35 U.S.C. 102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. *See, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Applicants submit that all of the pending claims are in condition for allowance. Therefore, a Notice of Allowance is requested. If the Examiner has any questions concerning the present Response, the Examiner is requested to contact the undersigned at (408) 774-6914. If any additional fees are due in connection with filing this Response, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. SUNMP575). A duplicate copy of the transmittal is enclosed for this purpose.

Respectfully submitted,  
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